

REMARKS

Initially, Applicants have amended claims 1-66. No new matter has been added. Additionally, Applicants believe that the foregoing comments overcome the rejections set forth in the 5 February 23, 2005 Office Action.

I. THE EXAMINER'S REJECTIONS

35 U.S.C. § 103

The Examiner rejected Claims 1, 2, 4, 5, 9-20, 22, 24-38, 10 42-46, and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over Ruffolo *et al.*, U.S. Patent Number 6,236,807 (hereafter "Ruffolo") in view of Millan, U.S. Patent Number 6,278,840 (hereafter "Millan") or Junkel, U.S. Patent Number 6,044,202 (hereafter "Junkel"). The Examiner states that Ruffolo *et al.*:

15 "shows an air freshener with a housing for holding a circuit having a light emitting diode, a heater disposed in a ceramic block for conducting or radiating heat, electrical 20 connectors to receive current from a power source, a container made of translucent material, a decorative shield, a wick inserted in the container, the housing with a socket for holding the container, and a dome 25 for venting out of facilitating the release of a heated substance." Office Action dated February 23, 2005, page 23.

The Examiner cited Millan and Junkel to show an air freshener 30 "with a resistor as the heater." Office Action dated February 23, 2005, page 2.

Next, the Examiner rejected Claims 3, 20, 21, 47, 48, 53, 54, and 58-66 as unpatentable over Ruffolo in view of Millan or Junkel in further view of Wattson, U.S. Patent Number 3,373,341 (hereinafter "Wattson") or Roland *et al*, U.S. Patent Number 5 3,386,005 (hereinafter "Roland"). The Examiner admitted that Ruffolo in view of Millan or Junkel do not teach the apparatus with a shunt diode including a full-wave bridge rectifier. See Office Action dated February 23, 2005, page 3. The Examiner cites Wattson and Roland for showing this feature. *Id.*

10 Third, the Examiner rejected Claims 6, 23, and 39 as being unpatentable over Ruffolo in view of Millan or Junkel in further view of Jackson, U.S. Patent Number 5,274,215 (hereinafter "Jackson") or Patel, U.S. Patent Number 5,716,119 (hereinafter "Patel"). Specifically, the Examiner admitted that Ruffolo in 15 view of Millan or Junkel does not show a fiber optical cable coupled to the light emitting diode. See Office Action dated February 23, 2005, pages 3-4. However, the Examiner cites Jackson and Patel for teaching an air freshener with a fiber optical cable. *Id.*

20 Next, Claims 7, 8, 40 and 41 are rejected as unpatentable over Ruffolo in view of Millan or Junkel in further view of Muderlak *et al.*, U.S. Patent Number 5,175,791 (hereinafter "Muderlak"). The Examiner cites Muderlak to teach an air freshener with an electrical thermal fuse to prevent

overheating, while admitting that the combination of Ruffolo and Millan or Junkel does not teach this limitation. *Id.*

Further, the Examiner rejected Claim 55 over Ruffolo in view of Millan, Junkel, Wattson and Roland, in further view of 5 Patel or Jackson. The Examiner stated that the combination of Ruffolo, Millan, Junkel, Wattson, and Roland teaches the invention except for a fiber optic cable. The Examiner cites Jackson and Patel to teach a device that utilizes optical cables for aesthetic purposes. *Id.*

10 Finally, the Examiner rejected Claims 56 and 57 as unpatentable over Ruffolo in view of Millan, Junkel, Wattson, and Roland in further view of Muderlak. The Examiner admitted that the combination of Ruffolo, Millan, Junkel, Wattson, and Roland failed to teach a device with an electrical thermal fuse. 15 See Office Action dated February 23, 2005, page 5. According to the Examiner, Muderlak is cited to "show an air freshener with an electrical thermal fuse to prevent overheating." *Id.*

II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

In order for a claimed invention to be obvious, either 20 alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the

claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03. Applicants respectfully submit that no combination of references teach the claim limitations, as amended, of the present 5 invention.

All of the Examiner's rejections rely on Ruffolo. Ruffolo discloses an air freshener with "an optional LED which is lit by electricity to indicate that the system has been powered and is evolving vapor from the cover." Col. 4, lns. 61-64 (emphasis 10 added). In addition, Ruffolo teaches that the LED light is disposed on the back of the housing. See Fig. 4. The housing is made of plastic. Col 3, ln. 16. Ruffolo does not suggest that the LED light can act to illuminate the housing. Indeed, Ruffolo discloses that the only purpose of the single LED light 15 is to act as a signal that the device is "turned on". Thus, Ruffolo fails to teach a device which utilizes more than one LED. This makes sense because the LED in Ruffolo is not meant for the purpose of illuminating a large portion of the device. In contrast, the claims, as amended, claim a device that uses a 20 plurality of light emitting diodes. These diodes are dispersed throughout the housing and are oriented such that they emit light from the housing. In essence, the LEDs emit enough light to act as a nightlight, not merely a faint indicator of whether the device is on or off.

Millan and Junkel were cited to show an air freshener with a resistor that acts as a heater. See Office Action, page 2. Watson and Roland were cited to show the use of a shunt diode as a full-wave bridge rectifier. See Office Action, page 3.

5 Jackson and Patel were cited to teach the use of a fiber optical cable as a source of illumination. See Office Action, page 4. Muderlak was cited to teach the use of a thermal fuse to prevent overheating. *Id.* None of the references teach an air freshener with a plurality of LED lights.

10 Since no combination of Ruffolo, Millan, Junkel, Patel, Jackson, or Muderlak teaches each and every claim limitation, the Examiner's rejections should be withdrawn.

In addition, an obviousness rejection is improper unless the prior art relied upon suggests the proposed 15 combination. See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Indeed, the Examiner "has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination." *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 20 1468, 1475 (Fed. Cir. 1988); see also, *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) ("When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make modification."). A finding of

obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or motivation. See *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail to provide any teaching, suggestion or motivation for the combination asserted by the Examiner in rejecting the pending claims. It is well settled that:

10 "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

15 Specifically, Applicants respectfully submit that there is no motivation for the combination of Ruffolo in view or Millan, Junkel, Watson, Roland, Jackson, Patel, and Muderlak. According to MPEP §2143.01, the fact that a claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. Indeed, "a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made

because the references relied upon teach all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the 5 references." MPEP §2143.01; *see also Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App & Inter. 1993).

In the present rejection, the Examiner stated, with respect to the combination of Ruffolo and Millan or Junkel "[i]t would have been obvious to a person with ordinary skill in the art to 10 adapt Ruffolo with the resistor as the heater to alternatively provide the necessary power to heat the volatile substance, and further adapt with a rectifier to rectify the AC current source to provide a constant DC to power the heater." See Office Action, ¶ 2. In short, the Examiner stated that it would have 15 been obvious because the references, when combined, teach the invention as claimed. However, nothing in the references themselves suggest an objective reason to combine the references, nor has the Examiner proffered one. Without such an objective reason, combining these references is improper.

20 Therefore, the rejection of the claims should be withdrawn.

The Applicants acknowledge the Examiner's reliance on Jackson or Patel as disclosing a fiber optic cable coupled to a lighting source to provide illumination along the optical cable. However, the Applicant respectfully submits that the combination

of Ruffolo in view of Millan, Junkel, Watson, and Roland with Jackson or Patel is improper. Jackson discloses a fiber optic cable as an illuminating source in a portable heating tray. Indeed, heating trays are a vastly different technology than air 5 fresheners. Similarly, Patel is directed to a lighting system for rollerblades. Again, the two technologies are drastically different from the claimed invention. Moreover, Applicants respectfully submit that there is no motivation in the references themselves for combining Ruffolo, Millan, Junkel, 10 Watson, Roland, Jackson and Patel as relates to the present invention.

The cited references provide no such motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of 15 a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

20 "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art 25 that existed at the time the invention was made." *Seasonics v. Aerasonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

30 In addition, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will

undoubtedly recognize that such a position is merely an "obvious to try" argument.

At best, it might be obvious to try such a modification, but of course, "obvious to try" is not the standard for 5 obviousness under 35 U.S.C. § 103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 10 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

15 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the 20 teachings of Applicant's own disclosure. No such motivation is provided by the references themselves.

Thus, the present invention, for the first time, discloses novel methods and apparatus for air fresheners with nightlight capabilities. This represents a vast improvement over the prior 25 art, and is not taught or disclosed anywhere in the prior art. Further, the cited references neither teach nor suggest the novel and nonobvious features of this invention.

Therefore, the combination of references is not proper and the rejection of the claims should be withdrawn.

CONCLUSION

Applicants submit that the specification, drawings, and all 5 pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current invention, the amendments are in no way related to patentability. Early and favorable action is 10 accordingly solicited.

Respectfully submitted,

Date: _____



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